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EXAMINER

PEFFLEY, M

ART UNIT

PAPER NUMBER

3739

8

DATE MAILED:

04/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/177,502

Applicant(s)

SLATER, CHARLES R.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-29 and 40-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-29 and 40-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892) 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 18) ☐ Notice of Informal Patent Application (PTO-152)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 19) ☐ Other: _____

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Applicant's request for reconsideration, filed February 17, 2000, has been fully considered by the examiner. The following is a complete response to the communication of February 17, 2000.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claims 24, 25, 28, 29, 40, 41, 44 and 46-56 are rejected under 35 U.S.C. 102(g) based upon claims 1-11 of Patent No. 5,352,222.

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

Claims 26, 27, 42, 43 and 45 are rejected under 35 U.S.C. 102(g)/103(a) based upon claims 1-11 of Patent No. 5,352,222.

While Rydell ('222) does not specifically disclose the use of ceramic as the insulative layer in the patented claims, the examiner maintains that using any well known insulation between the metal layers of the Rydell blades would have been an

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obvious design choice. In particular, Rydell teaches that it is known to provide an insulating ceramic layer upon a metallic substrate in scissors devices (see column 2, lines 20-34). To have used such a ceramic insulative layer in lieu of the disclosed epoxy insulative layer in the patented claims would have been an obvious modification for one of ordinary skill in the art, particularly in view of the teaching of Rydell.

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

Collateral Estoppel

Applicant is also informed that claims 24-29 and 40-56 are subject to rejection on the ground of collateral estoppel. Applicant's failure to properly move under 37 CFR 1.633(c)(1) to add a second count to the interference proceedings (i.e. a count drawn to the subject matter of the instant application claims) has created the ground of estoppel as set forth in 37 CFR 1.658(c). See MPEP 2363.03 (particularly examples 1-3).

Response to Arguments

Applicant's arguments filed February 17, 2000 have been fully considered but they are not persuasive.

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It is again noted that an adverse decision was rendered against applicants in the judgment of Interference No. 103,765. The examiner will attempt to clarify the position of the office by summarizing and addressing the claims of the involved applications.

1. Applications involved

1 – Serial Number 08/213,671 which issued as US Patent No. 5,352,222

(referred to as '222)

2 – Serial Number 08/724,997 which is a reissue application of '222

(referred to as '997)

3 – Serial Number 08/354,992 which received an adverse decision in Interference No. 103,765

(referred to as '992)

4 – Serial Number 09/177,502 which is a divisional of the '992 application

(referred to as '502 or "the instant application")

5 – Interference No 103,765

(referred to as '765)

2. History/Summary of "Blade Claims"

During the prosecution history of the '222 patent, a restriction requirement was held by the examiner. Of particular interest, a distinction was made between the "blade claims" (i.e. claims 1-9) and the "electrosurgical instrument claims" (i.e. claims 10-20). The instant examiner was not the examiner to make the restriction requirement; however, the instant examiner maintains that the restriction was proper. The "blade

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claims" were a subcombination of the "electrosurgical instrument claims", particularly since the broadly recited "blade" would have been found on any other type of device (i.e. knife, scalpel, etc.).

Applicant's claims 24-29 filed in the '992 application (and included in the instant application) were deemed not drawn to the count. These claims were drawn to an "endoscopic scissor blade". While the examiner maintains that these claims were not drawn to the count, they were not patentably distinct for the purposes of restriction. That is, had Rydell presented claims to "an endoscopic scissor blade" rather than simply to "a blade" in the '671 application (which matured to the '222 patent), these claims would not have been restricted.

In making a combination-subcombination restriction requirement, the examiner must show that (1) the combination as claimed does not require the particulars of the subcombination as claimed, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). Rydell's "blade claims" clearly had utility by itself as a scalpel or other knife blade. However, had Rydell used the "endoscopic scissor blade" preamble, those claims would not have been deemed to possess separate utility in view of the more limiting preamble, and no restriction requirement would have been made.

3. Administrative Patent Judge Pate's Decision to not add second count

In Paper No. 31 of the '765 Interference, APJ Pate made an interlocutory decision denying Rydell's preliminary motion to add a second count. The second count

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proposed by Rydell was drawn to "an endoscopic scissor blade". APJ denied entry of this second count stating "claims 15-17 of the senior party's reissue application are not patentable to the senior party under 35 USC 251" and "the newly proposed count is unpatentable to the senior party for the reasons stated in the opposition to the motion to add a count" (see pages 3-4 of Paper No. 31 from the '765 file). Rydell's claim 15 was identical to the proposed second count, and APJ Pate's decision was based on the premise that Rydell was recapturing matter specifically canceled during prosecution of the '222 patent.

It is hereby noted that APJ Pate's interlocutory motion of the preliminary motion is not binding, and the determination of whether or not Rydell's claims 15-17 (as presented in the '724 application) were an attempt to recapture subject matter was within the examiner's jurisdiction after termination of the interference proceedings. As stated previously, the examiner's position is that the claims directed to the "endoscopic scissors blade" (i.e. Rydell's claims 15-17) are patentably different from the "blade" filed in the '222 application file. In short, Rydell's claims to the "endoscopic scissors blade" are not deemed by the examiner to be a recapture of the "blade" subject matter which was non-elected during prosecution of the '222 file.

Moreover, APJ Pate's decision in Paper No. 31 did not establish that Rydell was not entitled to the invention of the endoscopic scissors blade as asserted by applicants. Rather, APJ Pate's decision was only grounded under the recapture doctrine of 35 USC 251, and that was the only issue being considered at the time.

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4. Applicant' failure to take necessary steps

As stated in 37 CFR 1.658(c), "A losing party who could have properly moved, but failed to move, under § 1.633 or 1.634, shall be estopped to take *ex parte* or *inter partes* action in the Patent and Trademark Office after the interference which is inconsistent with that party's failure to properly move".

In the present situation, applicants failed to file a preliminary motion to add a second count drawn to the endoscopic scissors blade. As such, applicants have failed to properly move or take the necessary steps for interference purposes, and has therefore disclaimed the subject matter.

Again, it is stressed that APJ Pate's interlocutory decision not to add the second count proposed by Rydell was 1) not binding on the Office, and 2) was not grounded in priority proceedings. The decision of APJ Pate was based on the recapture of subject matter in a reissue application, and the examiner disagrees with the contention that Rydell was attempting to recapture subject matter. Further, APJ Pate's decision to grant applicants the right to file a divisional application (i.e. the '502 application) was not a decision that applicants had priority to that claimed subject matter. Rather, that decision was a procedural issue which did not mitigate applicant's need to properly move (i.e. propose a second count) to avoid estoppel of the subject matter.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on 9 hour.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda M Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Michael Peffley/mp
Primary Examiner
Art Unit 3739
April 18, 2000

Michael Peffley
MICHAEL PEFFLEY
PRIMARY EXAMINER
AU3739